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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,183	10/05/2001	Akihiko Toyoshima	50P4257.05	3119

36738 7590 05/30/2008
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EXAMINER

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ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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05/30/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIHIKO TOYOSHIMA

Appeal 2008-0361
Application 09/972,183
Technology Center 2600

Decided: May 30, 2008

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and MARC S. HOFF,
Administrative Patent Judges.

HAIRSTON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 26 and 27. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

Appellant's claimed invention is to a system for rendering difficult the use of a wireless module (Spec. 4:12) with an unauthorized peripheral device which includes the wireless module having a wireless transceiver (Spec. 4:13) and a security code (Spec. 5:13-20). The peripheral device, which has an input device and a display, communicates with the wireless module only if a human user provides the security code to the peripheral device and the security code provided to the peripheral device matches the security code provided to the wireless module (Spec. 5:22-30). The peripheral device is a portable computing device and the wireless module is removably engageable with the peripheral device (Spec. 3:7-9 and Abstract). A server is used to deactivate the wireless module in the event that the wireless module is lost and/or stolen (Spec. 7:13-21).

Claim 26, reproduced below, is representative of the subject matter on appeal.

26. A system for rendering difficult the use of a wireless module with an unauthorized peripheral device, comprising:

at least one wireless module including a wireless transceiver, the wireless module including at least one security code;

at least one peripheral device having an input device and a display and communicating with the wireless module only if a human user provides the security code to the peripheral device and the security code provided to the peripheral device matches the security code provided to the wireless module, the peripheral device being a portable computing device, the wireless module being removably engageable with the peripheral device; and

using a server to deactivate the wireless module in the event that the wireless module is lost and/or stolen.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Pettersson	US 6,615,057 B1	Sep. 02, 2003 (filed May 05, 1999)
Helle	US 6,662,023 B1	Dec. 09, 2003 (filed Jul. 06, 2000)
Kawashima	US 6,804,730 B1	Oct. 12, 2004 (filed Nov. 17, 1999)

Claims 26 and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima in view of Pettersson and further in view of Helle.

OBVIOUSNESS

The issue before us is whether the Examiner erred in rejecting claims 26 and 27 under 35 U.S.C. § 103(a) as obvious over Kawashima in view of Pettersson and further in view of Helle. The issue turns on whether the peripheral device as

disclosed by Kawashima is capable of wireless communication and whether the Examiner's articulated reasoning (i.e., "enabling a secure wireless transfer") (Ans. 4) for combining Kawashima and Pettersson possesses a rational underpinning to support the legal conclusion of obviousness.

FINDINGS OF FACT

The relevant facts include the following:

1. Kawashima teaches using a memory card 1 having a flash memory 11 which is inserted in the PCMCIA slot in order to gain access to CPU 121 (col. 9, ll. 41-46).
2. Pettersson teaches a module including a wireless transceiver and memory permitting wireless data transfer (col. 6, ll. 25-30 and col. 8, ll. 21-26).

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383

U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence. *Id.*

The Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, citing *In re Kahn*, 441 F.3d at 988, stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. at 1741. However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Did the Examiner err in combining Kawashima and Pettersson?

Appellant argues that there is no suggestion “in the primary reference that its PCMCIA card even be wireless” (Br. 5). Appellant further argues “[t]hat the secondary reference (Pettersson) teaches a wireless transmitter for conveying

subscriber information is of no help to the *prima facie* case, because passing wireless subscriber information is irrelevant to Kawashima. Indeed, nothing in the relied-upon portions of Pettersson motivates one to provide security to the wireless transmitter at all, much less to a wireless module of the kind explicitly recited in the claims” (Br. 5).

As stated *supra*, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d at 1445. Furthermore, the Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d at 988.

Claim 26 recites *inter alia*: “at least one peripheral device having an input device and a display and communicating with the wireless module.” Claim 27 recites, *inter alia*: “permitting the peripheral device to access data on the wireless module.” Therefore, both claims require the peripheral device to communicate with the wireless module.

Kawashima teaches using a memory card 1 having a flash memory 11 which is inserted in the PCMCIA slot in order to gain access to CPU 121 (Finding of Fact 1), which Examiner equated to the claimed peripheral device (Ans. 3). The Examiner determined that Kawashima did not disclose a module having a wireless transceiver (Ans. 4). Pettersson teaches a module including a wireless transceiver and memory permitting wireless data transfer (Finding of Fact 2). The Examiner’s articulated motivation to combine Kawashima with Pettersson was for “the simple purpose of enabling a secure wireless transfer” (Ans. 4). However, this motivation

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does not possess a rational underpinning to support the legal conclusion of obviousness, because Kawashima's peripheral device is a memory card with a flash drive which is not capable of wireless communication. *In re Kahn*, 441 F.3d at 988.

Thus, the Examiner did not meet the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d at 1445.

We are thus persuaded by Appellant's argument that claims 26 and 27 are not obvious over Kawashima in view of Pettersson and further in view of Helle since the peripheral device of the combination is not capable of communicating with the wireless module (Findings of Fact 1-2 and Ans. 4).

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 26 and 27 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 26 and 27 is reversed.

REVERSED

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